

## **REMARKS**

Pursuant to 37 C.F.R. §1.111, reconsideration of the instant application, as amended herewith, is respectfully requested. Entry of the amendment is requested.

Claims 1-60 are presently pending before the Office. No claims have been canceled. Applicant has amended the specification and the claims for consistency of terms to render certain terms more acceptably generic and according to recommendations of the Examiner. No new matter has been added. Support for the amendments can be found throughout the specification as originally filed. Applicant is not intending in any manner to narrow the scope of the originally filed claims.

The Examiner's Action mailed June 16, 2004 and the references cited therein have been carefully studied by Applicant and the undersigned counsel. The amendments appearing herein and these explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is believed to be in condition for allowance.

The Examiner has rejected claims 1-18, 20-47 and 49-60 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 7, 8, 10-12, 14-17, 26, 35, 36, 38, 44-47, 51-53, 61 and 62 of US 6,540,966 and claims 19 and 48 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 49-60 of US 6,540,966 in view of Pub. No. 20030113597, both the patent and the application published being owned by inventor-applicant Ruggero M. Santilli. Although Applicant does not necessarily agree with the Examiner, in order to advance the case to

allowance, Applicant herein submits through his attorney of record, a terminal disclaimer and fee to obviate the double-patenting rejection.

The Examiner has rejected claims 1-60 under 35 USC 112, second paragraph, for the reasons outlined on pages 5-7 of the Office Action. Applicant has amended the claims to address the recommendations and comments of the Examiner concerning the language of the claims. Withdrawal of the rejections is requested.

The Examiner has objected to the specification essentially for lacking certain titles to sections. Applicant submits that the regulations do not specifically require titles to sections, only that the application be arranged in a certain format. It is clear from the reading of the specification that the format arrangement has been met. Further, the specification has been amended to delete the term "magnegas" which is now being used by Applicant as a trademark brand for a clean combustible gas produced by the equipment claimed in the instant application.

In order to advance the case to allowance, Applicant herein amends the specification as requested by the Examiner.

The Examiner has rejected claims 1-60 under 35 U.S.C. §112, first paragraph, for the reasons set forth on page 4 of the Office Action. Applicant respectfully traverses the rejection of claims 1-60.

First, Applicant is not claiming the gas produced so even though the description mentions certain characteristics of the gas produced, the Examiner can not assert that the "... claim(s) contains subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor ... had possession of the claimed invention." The important issue is that the gas produced is a clean burning combustible gas similar to that produced in US 6,540,966, and three other patents issued to Applicant. In order to advance the case to allowance, Applicant has amended the specification and claims.

Further, in this regard, the Examiner states that "the specification, while being enabling for the forming of an electric arc between electrodes, does not reasonably provide enablement for the forming of an electric arc between electrodes and copper holders." Applicant respectfully disagrees. Clearly, a review of the specification and Figs. 3a and 3b show that the arc is between the electrodes being held by the copper holders. Nevertheless, Applicant has amended the language of the claim to clarify that the arc is between the electrodes, as is understood by those skilled in the art.

Applicant is not persuaded that those skilled in the art cannot define or determine the metes and bounds of Applicant's invention.

Satisfaction of the enablement requirement, of course, is a question of law. To provide answers to this question, the disclosure is analyzed on a "how to make" criteria and on a "how to use" criteria.

Applicant has clearly set forth a concise disclosure on how to make the invention. Applicant also has clearly demonstrated how to use the invention. No authority has been cited to indicate that any of the specific claimed embodiments could not be made or could not be used as taught by Applicant. In short, there is no reasonable basis for doubting that Applicant's claimed invention could be made and/or used.

In particular, those skilled in the art would not find the invention as claimed to be unduly broad in the context of the Specification. Claims certainly would not be read to cover inoperative embodiments.

As mentioned above, Applicant respectfully submits that the broad scope is supported by the specification. The claims provide a clear warning to others as to what will constitute infringement. The standard of review is the rule of reason.

The Federal Circuit stated the standard for determining compliance with the written description requirement as follows:

Although the applicant does not have to describe exactly the subject matter claimed, the description must clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed. The test for sufficiently of support . . . is whether the disclosure of the application reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.

Vas-Cath, Inc., v., Mahurkar, 935 F.2d 1595, 19 U.S.P.Q.2d 1111 (Fed. Cir. 1991). For purposes of this inquiry, the invention is whatever is claimed.

Further, it should be noted that the enablement requirement under Section 112 may also be satisfied even if a person of ordinary skill in the art must conduct a certain, limited degree of experimentation in order to reproduce the invention. This principle is uniformly recognized by all courts dealing with patent matters.

By way of emphasis, the courts have also consistently held that the disclosure of invention set forth by an Applicant must be given a presumption of correctness and operativeness by the Office and that the only relevant concern of the Office should concern the truth of the assertions contained in the disclosure. The court in In re Marzocchi, 439 F.2d 220, 169 U.S.P.Q. 367 (C.C.P.A. 1967) states this principle with clarity:

As a matter of Patent Office practice, then, a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented **must** be taken as in compliance with the enabling requirement of the first paragraph of §112 **unless** there is a reason to doubt the objective truth of the statement contained therein which must be relied on for enabling support . . . In any event, it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain **why** it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.

Applicant respectfully submits that the language and format of the amended claims and specification clarify the issues raised in the Examiner's Action. Accordingly, in view of the present amendments and arguments, Applicant respectfully requests that the Examiner withdraw the rejection of the claims under 35 U.S.C. §112, first paragraph.

### CONCLUSION

Even though the initial claims in this important patent application were drawn to a new, useful and nonobvious invention, they have now been amended to increase their specificity of language. Applicant respectfully submits that claims 1-60 are patentable over the art of record.

A Notice of Allowance is earnestly solicited.

If the Office is not fully persuaded as to the merits of Applicant's position, or if an

Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (727) 538-3800 would be appreciated.

Very respectfully,

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